



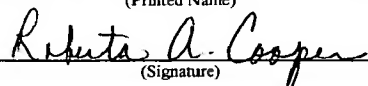
02/22/06

Atty. Dkt. No. 035451-0165 (3703.Palm)

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Wong et al.
Title: OBJECT TAGGING SYSTEM
AND METHOD
Appl. No.: 09/998,079
Filing Date: 11/30/2001
Examiner: Pham, Tuan
Art Unit: 2681

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Sir:

Transmitted herewith are the following documents for the above-identified application.

- ☒ [X] Brief On Appeal (23 pages).
- ☒ [X] Credit Card Payment Form in the amount of \$500.00 for Appeal Fee. The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Respectfully submitted,

Date 2/21/2006

By Chad E. Bement

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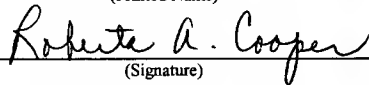
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BRIEF ON APPEAL

Mail Stop APPEAL BRIEF - PATENTS

P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 41.37, this Appeal Brief is being filed together with a credit card payment form in the amount of \$500.00 covering the 37 C.F.R. 41.20(b)(2) appeal fee. If this fee is deemed to be insufficient, authorization is hereby given to charge any deficiency (or credit any balance) to the undersigned deposit account 06-1447.

This paper is being filed in response to the final Office Action dated September 19, 2005 (finally rejecting claims 1, 3-11, 13-21, and 23-29). The Notice of Appeal was filed on December 19, 2005. Appellant respectfully requests favorable reconsideration of the application.

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1. REAL PARTY IN INTEREST

The real party in interest is the assignee of record, Palm, Inc. (as recorded in the records of the United States Patent and Trademark Office at Reel/Frame 012339/0973 on November 30, 2001).

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences that will directly affect, be directly affected by, or have a bearing on the present appeal, that are known to Appellant or Appellant's patent representative.

3. STATUS OF CLAIMS

This is an appeal from the final Office Action dated September 19, 2005, finally rejecting claims 1, 3-11, 13-21, and 23-29. Claims 1, 3-11, 13-21, and 23-29 are on appeal.

4. STATUS OF AMENDMENTS

Claims 1, 3-11, 13-21, and 23-29 were pending in the application when a final Office Action dated September 19, 2005 was issued. No claims have been amended in the present application subsequent to the receipt of the final Office Action dated September 19, 2005.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 is directed to a method (200) (see Specification, page 7, paragraph [0022]; FIG. 2) of indexing information stored on a portable electronic device (100) (see Specification, pages 5-6, paragraph [0019]; FIG. 1). The method (200) includes receiving an association signal (210) (see Specification, page 7, paragraph [0022]; FIG. 2) by the portable electronic device (100). The association signal provides an indication of adjacent resources (see Specification, pages 6-7, paragraph [0021]). The method (200) also includes accessing (220) a database (150) including a table storing relationships between data stored on the portable

electronic device (100) and the association signal (see Specification, page 7, paragraph [0022]; FIGS. 1-2). The method also includes indexing (230) the data based on the relationships accessed in the database (150) (see Specification, page 7, paragraph [0022]; FIG. 2) and prioritizing the indexed data (240) (see Specification, page 7, paragraph [0022]; FIG. 2).

Independent claim 11 is directed to a portable electronic device (100) (see Specification, pages 5-6, paragraph [0019]; FIG. 1). The portable electronic device (100) includes a processor (110) and a transceiver (130) coupled to the processor (110) (see Specification, pages 5-6, paragraph [0019]; FIG. 1). The transceiver (130) is configured to receive and transmit communication signals (see Specification, pages 5-6, paragraph [0019]; FIG. 1). The device (100) also includes a memory (120) coupled to the processor (110) and a program stored in the memory (120) and running on the processor (110) that is configured to receive an association signal (see Specification, pages 6-7, paragraph [0021]; FIG. 1) by the transceiver (130). The association signal provides an indication of adjacent resources (see Specification, pages 6-7, paragraph [0021]). The program is also configured to access a database (150) including a table storing relationships between data stored on the portable electronic device (100) and the association signal (see Specification, pages 6-7, paragraph [0021]; FIG. 1). The program is further configured to index the data based on the relationships accessed in the database (150) and to prioritize the indexed data (see Specification, pages 6-7, paragraph [0021]).

Independent claim 21 is directed to a handheld computer (100) (see Specification, page 3, paragraph [0013]; pages 5-6, paragraph [0019]; FIGS. 1 and 4). The handheld computer (100) includes a processor (110), a memory (120) coupled to the processor (110), and a display (114, 140) coupled to the processor (110) (see Specification, pages 3-4, paragraph [0015]; pages 5-6, paragraph [0019]; FIGS. 1 and 4). The handheld computer (100) also includes a program running on the processor (110) and configured to identify an adjacent known object (160, 170, 180) (see Specification, pages 6-7, paragraph [0021]; FIG. 1) and configured to index information stored in the memory (120) of the device based on the known object (see

Specification, pages 6-7, paragraph [0021]). The program is also configured to prioritize the indexed information (see Specification, pages 6-7, paragraph [0021]).

6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues on appeal are (1) whether claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 may properly be rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,929,848 (“Albukerk et al.”) in view of U.S. Published Patent Application No. 2002/0078075 (“Colson et al.”); and (2) whether claims 4-6, 14-15, 17, 24-25, and 27 may properly be rejected under 35 U.S.C. § 103(a) as being unpatentable over Albukerk et al. in view of Colson et al., and further in view of U.S. Published Patent Application No. 2002/0019584 (“Schulze et al.”).

7. ARGUMENT

I. LEGAL STANDARDS

All claim rejections at issue in this appeal are made under 35 U.S.C. § 103(a)¹ The legal standards under 35 U.S.C. § 103(a) are well-settled.

Obviousness under 35 U.S.C. § 103(a) is a legal conclusion involving four factual inquiries:

- (1) the scope and content of the prior art;
- (2) the differences between the claims and the prior art;
- (3) the level of ordinary skill in the pertinent art; and
- (4) secondary considerations, if any, of non-obviousness.

¹ “A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.” 35 U.S.C. §103(a).

Litton Systems, Inc. v. Honeywell, Inc., 87 F. 3d 1559, 1567, 39 U.S.P.Q. 2d 1321, 1325 (Fed. Cir. 196). See also Graham v. John Deere Co., 383 U.S. 1, 148 U.S.P.Q. 459 (1966).

In proceedings before the Patent and Trademark Office (PTO), the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984). A prima facie case of obviousness requires that the prior art reference or references teaches or suggests all of the claimed limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). “The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988); In re Lalu, 747 F.2d 703,705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 297 n.24, 227 U.S.P.Q. 657, 667 n.24 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 782 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). It is improper to combine references where the references teach away from their combination. See In re Grasselli, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983). When a reference teaches away from the claimed invention, that teaching is strong evidence of non-obviousness. See U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 79 (1966); In re Royka, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If the proposed combination of the references would change the principle of operation of the reference being modified, the teachings of the references are not sufficient to render the claims prima facie obvious. See In re Ratti, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). If proposed modification would render the prior art unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See In re Gordon, 733 F.2d 900,

221 U.S.P.Q. 1125 (Fed. Cir. 1984). Proceeding contrary to accepted wisdom is evidence of non-obviousness. See In re Hedges, 783 F.2d 1038, 228 U.S.P.Q. 685 (Fed. Cir. 1986).

As noted by the Federal Circuit, the “factual inquiry whether to combine references must be thorough and searching.” McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 USPQ.2d 1001 (Fed. Cir. 2001). Further, it “must be based on objective evidence of record.” In re Lee, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not in the applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990). “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” Lee (citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

II. REJECTION OF CLAIMS 1, 3, 7-11, 13, 16, 18-21, 23, 26, AND 28-29 UNDER 35 U.S.C. § 103(a) BASED ON ALBUKERK ET AL. IN VIEW OF COLSON ET AL.

In the final Office Action dated September 19, 2005, the Examiner rejected claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 under 35 U.S.C. § 103(a) as being unpatentable over Albukerk et al. in view of Colson et al.

Claim 1 is in independent form and claims 3 and 7-10 depend from claim 1.

Claim 11 is in independent form and claims 13, 16, and 18-20 depend from claim 11.

Claim 21 is in independent form and claims 23, 26, and 28-29 depend from claim 21.

The Examiner’s rejection of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 under 35 U.S.C. § 103(a) based on the combination of Albukerk et al. and Colson et al. should be reversed

because the Examiner has failed to establish a prima facie case of obviousness with regard to claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29. More specifically, for at least the reasons stated below, no proper combination of Albukerk et al. and Colson et al. teaches or suggests the subject matter of claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29.

To establish a prima facie case of obviousness based on a combination of prior art references under 35 U.S.C. § 103(a), the Examiner must first show that there is a suggestion or motivation to combine the teachings of these references. To satisfy this burden, the Examiner must show some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 972 F.2d 1260 (Fed. Cir. 1992). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte Skinner, 2 U.S.P.Q.2d 1788 (Bd. Pat. App. & Inter. 1986). In this case, the Examiner has not established that there would have been motivation or suggestion to combine the teachings of Albukerk et al. and Colson et al.

A. Claims 1, 3, and 7-10

In the final Office Action dated September 19, 2005, the Examiner acknowledged with regard to claim 1 that “Albukerk fails to teach the prioritizing data.” The Examiner, however, further stated that “Colson teaches such features (see figure 1, prioritization system 10, [0023, 0045]). The Examiner concluded that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Colson into view of Albukerk, in order to store and process the priority data from the database.” In an Advisory Action dated November 21, 2005, the Examiner elaborated on this conclusion by stating that:

In this case the motivation to do so found in the references themselves (i.e., in order to store and process the priority data from the data base so that only the highest priority data is stored on the limited storage resources of the client device as suggested by Colson et al. at column 2, [0012].

The Examiner thus suggests that achieving the advantage that “only the highest priority data is stored on the limited storage resources of the client device as suggested by Colson et al. at column 2, [0012]” would provide motivation to combine the teachings of Albukerk et al. and Colson et al. The Examiner, however, has not pointed to any express or implied recognition in either Albukerk et al. or Colson et al., or any convincing line of reasoning based on, for example, established scientific principles or legal precedent, that any such advantage cited in Colson et al. would be produced by the combination of these references. For example, the Examiner has not provided any indication how the teachings of Albukerk et al. or Colson et al. would have to be modified to include the teachings of Colson et al. to achieve such advantages, or how the prioritization system 10 of Colson et al. would work with the teachings of Albukerk et al. As such, the Examiner’s statements regarding the motivation to combine Albukerk et al. and Colson et al. do not evince the “thorough and searching inquiry” required by the U.S. Court of Appeals for the Federal Circuit. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). Instead of properly describing a motivation to combine the teachings of Albukerk et al. or Colson et al., the Examiner has apparently engaged in hindsight reasoning to combine such teachings using Appellants’ patent application as a road map to make such a combination.

In fact, one of ordinary skill in the art would not have been motivated modify the teachings of Albukerk et al. to include the prioritization system of Colson et al. to somehow arrive at the subject matter of claim 1 because Colson et al., when viewed as a whole, teaches away from the subject matter of claim 1. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). When a reference teaches away from the claimed invention, that teaching is strong evidence of non-obviousness. See U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 79 (1966); In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

In an Advisory Action dated November 21, 2005, the Examiner stated that “Examiner is only used the teaching of Colson how to process the priority data to combine with Albuquerk,” and that “the result is that the PDA of Albuquerk can be process the priority data based on the relationship accessed in the database.” Thus, the Examiner suggests that the “teaching of Colson how to process the priority data” may be entirely embodied in “the PDA of Albuquerk” to provide data prioritization. However, when properly viewed as a whole, Colson et al. teaches the prioritization of data as part of a synchronization process between two devices: (1) a client device (e.g., laptop computer 44, Internet appliance 45, or PDA 46) having a relatively limited storage capacity and (2) a device having a relatively higher data storage capacity (e.g., personal computer 42). See Colson et al., paragraphs [0017], [0026], and [0027]. The client device initiates the synchronization process and receives and stores prioritized data as a subset of the data stored on the a device having a relatively higher data storage capacity, but does not perform data prioritization. A data prioritization system 10 separate from the client device performs the data prioritization, but does not initiate the process or store or utilize the prioritized data. The data prioritization system 10 retrieves the prioritized data from a copy of the data stored in the device having the relatively higher data storage capacity (e.g., the personal computer 42) or otherwise communicates with the device having the relatively higher data storage capacity to retrieve the data. See Colson et al., paragraph [0032]. Thus, the way Colson et al. teaches “how to process the priority data” requires a separate data prioritization system 10 to implement a synchronization process between the client device and the device having a relatively higher data storage capacity (e.g., personal computer 42).

Thus, Colson et al., when viewed as a whole, teaches away from a process of prioritizing data stored on a portable electronic device using the portable electronic device to prioritize its own data as set forth in claim 1. Rather, one of ordinary skill in the art following the teachings of Colson et al. and Albuquerque et al. would arrive at a process wherein the personal interpretive device 101 initiates a process for synchronization with a data storage device having a relatively higher storage capacity (e.g., the base computer 111 or a remotely situated server 205) using a separate data prioritization system for purposes of prioritizing information each time a different

object is approached. Accordingly, one of ordinary skill in the art would not have been motivated modify the teachings of Albukerk et al. to include the prioritization system of Colson et al. to somehow arrive at the subject matter of claim 1.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because there is no suggestion or motivation to combine the teachings of Albukerk et al. and Colson et al. and that the rejection of claim 1 should be reversed. Furthermore, claims 3 and 7-10 depend from independent claim 1, and therefore the rejection of claims 3 and 7-10 should be reversed for at least the same reasons as discussed above with regard to claim 1. See 35 U.S.C. § 112 ¶ 4.

B. Claims 11, 13, 16, and 18-20

In the final Office Action dated September 19, 2005, the Examiner acknowledged with regard to claim 11 that “Albukerk fails to teach the prioritizing data.” The Examiner, however, further stated that “Colson teaches such features (see figure 1, prioritization system 10, [0023, 0045]). The Examiner concluded that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Colson into view of Albukerk, in order to store and process the priority data from the database.” In an Advisory Action dated November 21, 2005, the Examiner elaborated on this conclusion by stating that:

In this case the motivation to do so found in the references themselves (i.e., in order to store and process the priority data from the data base so that only the highest priority data is stored on the limited storage resources of the client device as suggested by Colson et al. at column 2, [0012].

The Examiner thus suggests that achieving the advantage that “only the highest priority data is stored on the limited storage resources of the client device as suggested by Colson et al. at column 2, [0012]” would provide motivation to combine the teachings of Albukerk et al. and Colson et al. The Examiner, however, has not pointed to any express or implied recognition in either Albukerk et al. or Colson et al., or any convincing line of reasoning based on, for example,

established scientific principles or legal precedent, that any such advantage cited in Colson et al. would be produced by the combination of these references. For example, the Examiner has not provided any indication how the teachings of Albukerk et al. or Colson et al. would have to be modified to include the teachings of Colson et al. to achieve such advantages, or how the prioritization system 10 of Colson et al. would work with the teachings of Albukerk et al. As such, the Examiner's statements regarding the motivation to combine Albukerk et al. and Colson et al. do not evince the "thorough and searching inquiry" required by the U.S. Court of Appeals for the Federal Circuit. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). Instead of properly describing a motivation to combine the teachings of Albukerk et al. or Colson et al., the Examiner has apparently engaged in hindsight reasoning to combine such teachings using Appellants' patent application as a road map to make such a combination.

In fact, one of ordinary skill in the art would not have been motivated modify the teachings of Albukerk et al. to include the prioritization system of Colson et al. to somehow arrive at the subject matter of claim 11 because Colson et al., when viewed as a whole, teaches away from the subject matter of claim 11. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). When a reference teaches away from the claimed invention, that teaching is strong evidence of non-obviousness. See U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 79 (1966); In re Royka, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

In an Advisory Action dated November 21, 2005, the Examiner stated that "Examiner is only used the teaching of Colson how to process the priority data to combine with Albukerk," and that "the result is that the PDA of Albukerk can be process the priority data based on the relationship accessed in the database." Thus, the Examiner suggests that the "teaching of Colson how to process the priority data" may be entirely embodied in "the PDA of Albukerk" to provide data prioritization. However, when properly viewed as a whole, Colson et al. teaches the

prioritization of data as part of a synchronization process between two devices: (1) a client device (e.g., laptop computer 44, Internet appliance 45, or PDA 46) having a relatively limited storage capacity and (2) a device having a relatively higher data storage capacity (e.g., personal computer 42). See Colson et al., paragraphs [0017], [0026], and [0027]. The client device initiates the synchronization process and receives and stores prioritized data as a subset of the data stored on the a device having a relatively higher data storage capacity, but does not perform data prioritization. A data prioritization system 10 separate from the client device performs the data prioritization, but does not initiate the process or store or utilize the prioritized data. The data prioritization system 10 retrieves the prioritized data from a copy of the data stored in the device having the relatively higher data storage capacity (e.g., the personal computer 42) or otherwise communicates with the device having the relatively higher data storage capacity to retrieve the data. See Colson et al., paragraph [0032]. Thus, the way Colson et al. teaches “how to process the priority data” requires a separate data prioritization system 10 to implement a synchronization process between the client device and the device having a relatively higher data storage capacity (e.g., personal computer 42).

Thus, Colson et al., when viewed as a whole, teaches away from a portable electronic device configured to prioritize its own data as set forth in claim 11. Rather, one of ordinary skill in the art following the teachings of Colson et al. and Albukerk et al. would arrive at a personal interpretive device 101 that initiates synchronization with a data storage device having a relatively higher storage capacity (e.g., the base computer 111 or a remotely situated server 205) using a separate data prioritization system for purposes of prioritizing information each time a different object is approached. Accordingly, one of ordinary skill in the art would not have been motivated modify the teachings of Albukerk et al. to include the prioritization system of Colson et al. to somehow arrive at the subject matter of claim 11.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because there is no suggestion or motivation to combine the teachings of Albukerk et al. and Colson et al. and that and the rejection of claim 11 should be reversed.

Furthermore, claims 13, 16, and 18-20 depend from independent claim 11, and therefore the rejection of claims 13, 16, and 18-20 should be reversed for at least the same reasons as discussed above with regard to claim 11. See 35 U.S.C. § 112 ¶ 4.

C. Claims 21, 23, 26, and 28-29

In the final Office Action dated September 19, 2005, the Examiner acknowledged with regard to claim 21 that “Albukerk fails to teach the prioritizing data.” The Examiner, however, further stated that “Colson teaches such features (see figure 1, prioritization system 10, [0023, 0045]). The Examiner concluded that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Colson into view of Albukerk, in order to store and process the priority data from the database.” In an Advisory Action dated November 21, 2005, the Examiner elaborated on this conclusion by stating that:

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The Examiner thus suggests that achieving the advantage that “only the highest priority data is stored on the limited storage resources of the client device as suggested by Colson et al. at column 2, [0012]” would provide motivation to combine the teachings of Albukerk et al. and Colson et al. The Examiner, however, has not pointed to any express or implied recognition in either Albukerk et al. or Colson et al., or any convincing line of reasoning based on, for example, established scientific principles or legal precedent, that any such advantage cited in Colson et al. would be produced by the combination of these references. For example, the Examiner has not provided any indication how the teachings of Albukerk et al. or Colson et al. would have to be modified to include the teachings of Colson et al. to achieve such advantages, or how the prioritization system 10 of Colson et al. would work with the teachings of Albukerk et al. As such, the Examiner’s statements regarding the motivation to combine Albukerk et al. and Colson et al. do not evince the “thorough and searching inquiry” required by the U.S. Court of Appeals

for the Federal Circuit. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). Instead of properly describing a motivation to combine the teachings of Albukerk et al. or Colson et al., the Examiner has apparently engaged in hindsight reasoning to combine such teachings using Appellants' patent application as a road map to make such a combination.

In fact, one of ordinary skill in the art would not have been motivated modify the teachings of Albukerk et al. to include the prioritization system of Colson et al. to somehow arrive at the subject matter of claim 11 because Colson et al., when viewed as a whole, teaches away from the subject matter of claim 11. A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983). When a reference teaches away from the claimed invention, that teaching is strong evidence of non-obviousness. See U.S. v. Adams, 383 U.S. 39, 148 U.S.P.Q. 79 (1966); In re Royka, 490 F. 2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

In an Advisory Action dated November 21, 2005, the Examiner stated that "Examiner is only used the teaching of Colson how to process the priority data to combine with Albukerk," and that "the result is that the PDA of Albukerk can be process the priority data based on the relationship accessed in the database." Thus, the Examiner suggests that the "teaching of Colson how to process the priority data" may be entirely embodied in "the PDA of Albukerk" to provide data prioritization. However, when properly viewed as a whole, Colson et al. teaches the prioritization of data as part of a synchronization process between two devices: (1) a client device (e.g., laptop computer 44, Internet appliance 45, or PDA 46) having a relatively limited storage capacity and (2) a device having a relatively higher data storage capacity (e.g., personal computer 42). See Colson et al., paragraphs [0017], [0026], and [0027]. The client device initiates the synchronization process and receives and stores prioritized data as a subset of the data stored on the a device having a relatively higher data storage capacity, but does not perform data prioritization. A data prioritization system 10 separate from the client device performs the

data prioritization, but does not initiate the process or store or utilize the prioritized data. The data prioritization system 10 retrieves the prioritized data from a copy of the data stored in the device having the relatively higher data storage capacity (e.g., the personal computer 42) or otherwise communicates with the device having the relatively higher data storage capacity to retrieve the data. See Colson et al., paragraph [0032]. Thus, the way Colson et al. teaches “how to process the priority data” requires a separate data prioritization system 10 to implement a synchronization process between the client device and the device having a relatively higher data storage capacity (e.g., personal computer 42).

Thus, Colson et al., when viewed as a whole, teaches away from a handheld computer configured to prioritize its own data as set forth in claim 21. Rather, one of ordinary skill in the art following the teachings of Colson et al. and Albukerk et al. would arrive at a personal interpretive device 101 that initiates synchronization with a data storage device having a relatively higher storage capacity (e.g., the base computer 111 or a remotely situated server 205) using a separate data prioritization system for purposes of prioritizing information each time a different object is approached. Accordingly, one of ordinary skill in the art would not have been motivated modify the teachings of Albukerk et al. to include the prioritization system of Colson et al. to somehow arrive at the subject matter of claim 21.

Therefore, it is respectfully submitted that the Examiner has failed to establish a prima facie case of obviousness because there is no suggestion or motivation to combine the teachings of Albukerk et al. and Colson et al. and that the rejection of claim 21 should be reversed. Furthermore, claims 23, 26, and 28-29 depend from independent claim 21, and therefore the rejection of claims 23, 26, and 28-29 should be reversed for at least the same reasons as discussed above with regard to claim 21. See 35 U.S.C. § 112 ¶ 4.

III. REJECTION OF CLAIMS 4-6, 14-15, 17, 24-25, AND 27 UNDER 35 U.S.C. § 103(a) BASED ON ALBUKERK ET AL. IN VIEW OF COLSON ET AL. AND FURTHER IN VIEW OF SCHULZE ET AL.

In the final Office Action dated July 26, 2005, the Examiner rejected claims 4-6, 14-15, 17, 24-25, and 27 under 35 U.S.C. § 103(a) as being unpatentable over Albukerk et al. in view of Colson et al. and further in view of Schulze et al. For the reasons stated below, the Examiner's rejection of claims 4-6, 14-15, 17, 24-25, and 27 should be reversed.

A. Claims 4-6

Claims 4-6 depend from claim 1. As explained above in section 7(II)(A), the combination of Albukerk et al. in view of Colson et al. fails to render the subject matter of claim 1 prima facie obvious. As to Schulze et al., it fails to make up for any of the deficiencies in the combination of Albukerk et al. in view of Colson et al. mentioned above. Because claims 4-6 depend from claim 1, the Examiner's rejection of claims 4-6 should be reversed for at least the same reasons as discussed above with regard to claim 1. See 35 U.S.C. § 112 ¶ 4.

B. Claims 14-15 and 17

Claims 14-15 and 17 depend from claim 11. As explained above in section 7(II)(B), the combination of Albukerk et al. in view of Colson et al. fails to render the subject matter of claim 11 prima facie obvious. As to Schulze et al., it fails to make up for any of the deficiencies in the combination of Albukerk et al. in view of Colson et al. mentioned above. Because claims 14-15 and 17 depend from claim 11, the Examiner's rejection of claims 14-15 and 17 should be reversed for at least the same reasons as discussed above with regard to claim 11. See 35 U.S.C. § 112 ¶ 4.

C. Claims 24-25 and 27

Claims 24-25 and 27 depend from claim 21. As explained above in section 7(II)(C), the combination of Albukerk et al. in view of Colson et al. fails to render the subject matter of claim

21 prima facie obvious. As to Schulze et al., it fails to make up for any of the deficiencies in the combination of Albukerk et al. in view of Colson et al. mentioned above. Because claims 24-25 and 27 depend from claim 21, the Examiner's rejection of claims 24-25 and 27 should be reversed for at least the same reasons as discussed above with regard to claim 21. See 35 U.S.C. § 112 ¶ 4.

8. **CONCLUSION**

In view of the foregoing, Appellants submit that (1) claims 1, 3, 7-11, 13, 16, 18-21, 23, 26, and 28-29 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Albukerk et al. and Colson et al.; and (2) that claims 4-6, 14-15, 17, 24-25, and 27 are not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Albukerk et al., Colson et al., and Schulze et al. Accordingly, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a notice of allowance respecting all pending claims should be issued.

Respectfully submitted,

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CLAIMS APPENDIX

1. A method of indexing information stored on a portable electronic device, comprising:

receiving an association signal by the portable electronic device the association signal providing an indication of adjacent resources;

accessing a database including a table storing relationships between data stored on the portable electronic device and the association signal; and

indexing the data based on the relationships accessed in the database; prioritizing the indexed data.

3. The method of claim 1, wherein the association signal includes a signal from a wireless access point.

4. The method of claim 1, wherein the association signal includes a Bluetooth signal.

5. The method of claim 1, wherein the association signal includes an IEEE 802.11 signal.

6. The method of claim 1, wherein the association signal includes a biometric signal.

7. The method of claim 1, wherein the association signal includes a wireless access point signal.

8. The method of claim 1, wherein the association signal includes an infrared signal.

9. The method of claim 1, further comprising:
- retrieving data stored on the portable electronic device and related to the associating signal.
10. The method of claim 9, further comprising:
- displaying the data retrieved.
11. A portable electronic device, comprising:
- a processor;
- a transceiver coupled to the processor, the transceiver configured to receive and transmit communication signals;
- a memory coupled to the processor; and
- a program stored in the memory and running on the processor configured to receive an association signal by the transceiver, the association signal providing an indication of adjacent resources, the program further configured to access a database including a table storing relationships between data stored on the portable electronic device and the association signal, the program configured to index the data based on the relationships accessed in the database and the program is configured to prioritize the indexed data.
13. The system of claim 11, wherein the association signal includes a signal from a wireless access point.
14. The system of claim 11, wherein the association signal includes a Bluetooth signal.

15. The system of claim 11, wherein the association signal includes an IEEE 802.11 signal.
16. The system of claim 11, wherein the association signal includes an infrared signal.
17. The system of claim 11, wherein the association signal includes a biometric signal.
18. The system of claim 11, wherein the association signal includes a wireless access point signal.
19. The system of claim 11, wherein the indexed data is retrieved by the program.
20. The system of claim 19, wherein the retrieved data is displayed on the portable electronic device.
21. A handheld computer, comprising:
 - a processor;
 - a memory coupled to the processor;
 - a display coupled to the processor; and
 - a program running on the processor and configured to identify an adjacent known object and configured to index information stored in the memory of the device based on the known object;

wherein the program is configured to prioritize the indexed information.

23. The handheld computer of claim 21, wherein the identity of the known object is associated with a signal from a wireless access point.

24. The handheld computer of claim 21, wherein the identity of the known object is associated with a Bluetooth signal.

25. The handheld computer of claim 21, wherein the identity of the known object is associated with an IEEE 802.11 signal.

26. The handheld computer of claim 21, wherein the identity of the known object is associated with an infrared signal.

27. The handheld computer of claim 21, wherein the identity of the known object is associated with a biometric signal.

28. The handheld computer of claim 21, wherein information associated with the known object is retrieved from memory of the device.

29. The handheld computer of claim 28, wherein the retrieved information is displayed on the display.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None